REMARKS

Claims 10 and 11 are pending in this application. Reconsideration and withdrawal of the rejections of the application are requested in view of the amendments and remarks presented herein, which place the application into condition for allowance, or at least into better condition for appeal.

Claims 11 and 12 were rejected under Section 102(b) as allegedly being anticipated by Lamph. The invention is directed to a method of producing neurite outgrowth by contacting a neuronal cell with an RARβ2 agonist. The Office Action argued that the teachings of Lamph inherently encompass stimulation of neurite outgrowth. The Advisory Action now argues that the teachings of Lamph inherently encompass contacting neuronal cells with an agonist of RARβ2. Therefore, the Examiner is relying upon a new inherency position to support his use of Lamph, presumably because Applicants successfully refuted his first basis in their April 24, 2006 Response.

Applicants reiterate that Lamph does not teach each and every element/step of the claim, either explicitly or inherently. Inherency requires the Examiner "to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). No such basis has been provided here.

Alzheimer's, Parkinson's, and Lou Gehrig's diseases are listed in Lamph as part of a laundry list of diseases that unidentified compounds can potentially be used for treating. The list includes, in addition to the three named neurodegenerative diseases, skin-related diseases, cancer of any number of organs and systems, diseases of the eye, viral conditions, inflammatory diseases, hormonal abnormalities, apoptotic conditions, and diseases associated with the immune system. For the Examiner to say that Lamph teaches that retinoic acid can be used to treat disease and that contacting neuronal cells with retinoic acid is inherent in the process of treating disease, is an incredible leap that the artisan simply could not (and would not) make. Moreover, Lamph does not teach the use of retinoic acid to treat disease. Instead, it teaches that RXR-binding compounds found in a screening process may be used for treating disease.

Moreover, Lamph never teaches that to treat a disease, you would necessarily contact neuronal cells with such a compound. Even if the disease is one involving neuronal cells, a process for treating such disease does not necessarily involve contacting neuronal cells. In fact, there are a multitude of ways to administer compounds such as retinoic acid for treating diseases,

as Lamph provides in another laundry list on page 44, lines 6-12. This list includes oral, rectal, transdermal, vaginal, transmucosal, intestinal, intramuscular, subcutaneous, intramedullary, intrathecal, intraventricular, intravenous, intraperitoneal, intranasal and intraocular. There is no evidence of which, if any, of the administration methods results in neuronal cells being contacted.

As one court clearly stated, "we do not see how a disclosure or combination of disclosures leaving one to rely on fortune in choosing the referred to material can function as an anticipation. Absent a showing of some reasonable certainty of inherency, the rejection . . . under 35 U.S.C. § 102 must fail." *Application of Joseph A. Brink, Jr.*, 419 F.2d 914, 918 (C.C.P.A. 1970). No such reasonable certainty has been demonstrated in this case. Furthermore, the Examiner is asking the skilled artisan to rely on fortune in picking and choosing bits of the disclosure in Lamph to come to the claimed invention. As the court stated in *Brink*, this is not permissible.

There is no example in the Lamph paper or in the art of administering retinoic acid or some other agonist of RARβ2 through the contacting of neuronal cells – and stimulating neurite outgrowth - prior to the filing date of the invention. Accordingly, the 102 rejection based upon the Lamph reference is improper and reconsideration and withdrawal of the rejection are requested.

CONCLUSION

The application is in condition for allowance. Favorable reconsideration of the rejection and prompt issuance of a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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